

REMARKS

The Examiner's indication that all of the items listed on Form PTO-1449 of the Information Disclosure Statements of April 12, 2002 and January 17, 2003 have been considered is acknowledged and much appreciated.

The election of the invention identified in the office action as "Group I, claims 1-35" is affirmed. Claims 1-31 and 33-35 are under consideration. It is submitted that new Claim 76, directed to a polishing composition, should be considered along the elected claims, and such consideration is hereby requested.

The Examiner objected to the declaration. A new declaration is submitted herewith and is believed to be sufficient.

The Examiner objected to the abstract as not being limited to a single paragraph. The paragraph break in the original abstract of the specification has been removed. The abstract is believed to be sufficient.

The Examiner objected to the specification as having a Table I and a Table 1. While the Examiner's suggestion of redefining tables is noted and appreciated, it is believed that Table I and Table 1 are sufficiently distinguishable as presently set forth in the specification. For example, paragraph [0020] refers to information "...shown in the following Table I" and Table I appears directly after this paragraph [0020]. Further, paragraph [0070] refers to information "...set forth below in Table 1." As Table I precedes paragraph [0070], and Table 1 follows paragraph [0070], it is believed that this reference could only be read as referring to Table 1. It is respectfully requested that the foregoing objection to the specification be withdrawn.

The Examiner objected to the specification with respect to Tables XV and XVII. The specification has been amended accordingly and is believed to be sufficient.

No new matter has been added by virtue of the foregoing amendments to the specification and the abstract of the specification.

Claims 1-18 and 33-35 have been rejected under 35 U.S.C. Section 112, second paragraph, as allegedly being indefinite.

The Examiner alleges that Claims 1 and 33 are indefinite as to the phrase "substantially planar." This allegation is traversed on the grounds that those skilled in the art would understand what is claimed when these claims are read in light of the specification.

See *Andrew Corp. V. Gabriel Electronics*, 6 U.S.P.Q. 2d 2010, as 2012-2014 (Fed. Cir. 1988) (Claims variously reciting “approach each other”, “close to”, “substantially equal”, or “closely approximate” deemed not indefinite.) By way of example, paragraph [0007] on page 3 of the specification describes substantial planarity in terms of polishing the substrate until metal excess is sufficiently removed to provide a substantially uniform profile across the substrate surface. This portion of the specification further defines a means of measuring surface uniformity, that is, via known wafer profiling techniques, provides examples of suitable surface uniformity values, and notes that acceptable uniformity values are typically established for each CMP process.

In view of the foregoing, it is submitted that the phrase “substantially planar” is sufficiently definite.

The Examiner alleges that various phrases in Claims 17, 18 and 33-35 are indefinite and provides various suggestions for amending these claims. These claims have been amended according to the suggestions of the Examiner. These amendments simply restate what was inherent in the claims. Claims 17, 18 and 33-35 are in no way narrowed by virtue of these amendments. Further, no new matter has been added by virtue of these amendments.

The Examiner has objected to Claim 16 under 37 CFR 1.75(c) as allegedly being of improper dependent form. The objection is respectfully traversed. Claim 1, from which Claim 16 depends, recites a combined amount sufficient to render the substrate surface substantially planar upon chemical-mechanical polishing thereof. The substrate surface has at least on feature thereon comprising a noble metal, a noble metal alloy, a noble metal oxide, or any combination thereof. It is submitted that the recitation of Claim 16 further defines the nature of the feature and thus further defines the composition of Claim 1, in that the combined amount sufficient to render the substrate surface substantially planar upon chemical-mechanical polishing thereof is influenced by the nature of the feature, such that Claim 16 is unobjectionable.

New Claim 76, which depends from any one of Claims 33-35, has been added. Claims 33-35 variously define a composition that provides the substrate surface as recited. The substrate surface has at least on feature thereon comprising a noble metal, a noble metal alloy, a noble metal oxide, or any combination thereof. It is submitted that the recitation of Claim 76 further defines the nature of the feature and thus further defines the composition of

any one of Claims 33-35, in that the composition is defined by what it provides, which is influenced by the nature of the feature, such that Claim 76 is unobjectionable.

Claims 1 and 4-18 have been rejected under 35 U.S.C. Section 102(a) or 35 U.S.C. Section 102(e), as allegedly anticipated by, or in the alternative, under 35 U.S.C. Section 103(a) as allegedly obvious over, either United States Patent No. 6,332,831 to Shemo *et al.* (hereinafter, "Shemo") or United States Patent No. 6,461,227 to Fang (hereinafter, "Fang").

Claims 2, 3, 19-31, and 33-35 have been rejected under 35 U.S.C. Section 103(a) as allegedly being unpatentable over either Shemo or Fang.

Claims 1, 4, 5 and 11-18 have been rejected under 35 U.S.C. Section 102(a) or 35 U.S.C. Section 102(e), as allegedly anticipated by, or in the alternative, under 35 U.S.C. Section 103(a) as allegedly obvious over, United States Patent No. 6,527,622 to Brusic *et al.* (hereinafter, "Brusic").

Claims 2, 3, 6-10, 19-31 and 33-35 have been rejected under 35 U.S.C. Section 103(a) as allegedly being unpatentable over Brusic in view of Fang.

Claims 1, 4, 5 and 11-18 have been rejected under 35 U.S.C. Section 102(a) or 35 U.S.C. Section 102(e), as allegedly anticipated by, or in the alternative, under 35 U.S.C. Section 103(a) as allegedly obvious over, United States Patent Publication No. 2003/0060135 to Moeggenborg *et al.* (hereinafter, "Moeggenborg").

Claims 2, 3, 6-12, 19-31 and 33-35 have been rejected under 35 U.S.C. Section 103(a) as allegedly being unpatentable over Moeggenborg in view of Fang and United States Patent Publication No. 2002/0076932 to Dirksen *et al.* (hereinafter, "Dirksen").

The effective filing dates of Shemo, Fang, Brusic, and Moeggenborg are April 6, 2000, October 17, 2000, January 22, 2002, and September 24, 2001, respectively. The effective filing date of Dirksen *et al.* is either December 17, 1999, *arguendo*, or December 15, 2000. Amongst these various dates, the earliest is December 17, 1999.

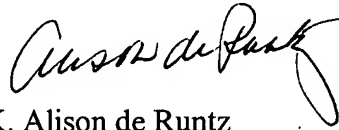
Attached is a Declaration of Zhefei J. Chen under 37 C.F.R. 1.131. The Declaration establishes invention of the subject matter of Claim 1 and at least Claims 2-10 and 13-17 depending therefrom, as well as the subject matter of Claim 19 and at least Claims 20-26, 29-31, 34 and 76, prior to December 17, 1999. Further, it is submitted that the rejections of Claims 11, 12, 18, 27, 28, 33, and 35 cannot stand in view of the foregoing.

In view thereof, withdrawal of the foregoing rejections of Claims 1-31 and 33-35 based on one or more of Shemo, Fang, Brusic, Moeggenborg, and Dirksen, is respectfully requested. Further, an indication that new Claim 76 is allowable is respectfully requested.

CONCLUSION

Claims 1-31, 33-35 and 76 define novel and non-obvious subject matter of the present invention. Therefore, an early notification that the application is in condition for allowance is earnestly solicited.

Respectfully submitted,



K. Alison de Runtz
Attorney of Record
Reg. No. 37,119

PARSONS HSUE & DE RUNTZ LLP
655 Montgomery Street, Suite 1800
San Francisco, CA 94111
(415) 318-1160
(415) 693-0194 (Fax)